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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,172

03/10/2004

David J. Krause

CS23879RA

4057

20280 7590 09/02/2009

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EXAMINER

TORRES, MARCOS L

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

09/02/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/797,172	<b>Applicant(s)</b> KRAUSE, DAVID J.	
	<b>Examiner</b> MARCOS L. TORRES	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-12 and 19-30 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 5-29-09 have been fully considered but they are not persuasive.
2. As to claims 1 and 10 applicant's representative [hereinafter applicant] first assert that Fette fails to disclose and then recite the entire claim 1 and 10; later applicant elaborate and really disclose what he believe is missing. Applicant assert that Fette fails to disclose "...while operating in CDMA/first communications mode, generating an origination message including information indicating an ability of the multi-mode wireless communications device to operate in GSM/second communications mode."; in step 303 as disclosed in col. 7, lines 41-49, Fette discloses that is going to request permission to configure the mobile device and operate in a different communication mode, in col. 8 last paragraph recites:

In step 320, the information is tested to validate the information. In a preferred embodiment, when information loaded into a radio is verifiable, the information is tested to check the information. For example, **when a cellular phone is operated in the United States (e.g., home location), the phone may be configured to operate as a CDMA phone.** When the phone is operated in Europe (e.g., remote location), **the phone may be configured to operate as a GSM phone.** In this example, **the phone is configured for use as a GSM phone prior to the user departing from the home location.**

As seen in the example of col. 8 while operating in the USA [CDMA communications mode], the user is going to request to use his phone in GSM prior to departure. So, the request will state something like: Can I be configured as GSM? It is clear that the mobile

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phone when request configuration about an operating mode it is indicating the ability to operate in that mode.

3. Applicant's arguments with respect to claim 19 have been considered but are moot in view of the new ground(s) of rejection.

4. Regarding claim 25, applicant asserts that Karabinis fails to disclose "...generating a channel assignment message for the multimode mobile station operating in a first communications mode on the first network in response to the message; assigning the multimode mobile station to a second network in the channel assignment message."; for example, Karabinis discloses generating a channel assignment message for the multimode mobile station operating in a terrestrial in response to the message; assigning the multimode mobile station to a satellite network in the channel assignment message (see par. 0259-0261).

5. Regarding claim 25, applicant asserts that Fette fails to disclose "...receiving a channel assignment message while operating in a first mode pursuant to a first communications protocol, the channel assignment message including channel assignment information for a mode of operation pursuant to a second communications protocol; transitioning to one of an access grant channel or a dedicated channel based on the channel assignment information for the different mode of operation."; one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case the primary reference Karabinis discloses everything except the use of

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different protocols; the secondary reference discloses the use of different protocols.

Thereby the combination of the references teaches all the limitations set forth in the claim.

6. The rest of the arguments they fall for the same reasons as shown above.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 5, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Fette 6052600.

As to claim 1, Fette discloses a method in a multi-mode wireless communications device (see col. 2, lines 46-60) capable of operating in CDMA and GSM communications modes (see col. 5, lines 5-13; col. 6, lines 3-23), the method comprising: operating the multi-mode wireless communications device in CDMA communications mode (see col. 8, lines 54-59); while operating in CDMA communications mode [in the United States as the example shown], generating an origination message [SMS request message] including information indicating an ability of the multi-mode wireless communications device to operate in GSM communications mode [note that because the request message was sent prior departure was sent in the

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actual CDMA mode requesting permission to use GSM] (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23).

As to claim 5, Fette discloses a method of transmitting the origination message while operating in CDMA communications mode [note that because the request message was sent prior departure was sent in the actual CDMA mode requesting permission to use GSM] (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23).

As to claim 10, Fette discloses a method in a multi-mode wireless communications device capable of operating in first and second communications modes in corresponding first and second networks (see col. 5, lines 5-13; col. 6, lines 3-23), the method comprising: operating the multi-mode wireless communications device in the first mode communications mode on the first network (see col. 8, lines 54-59); while operating in the first communications mode, generating a message including information indicating an ability of the multi-mode wireless communications device to operate in a second communications mode on the second network, the message is one of an origination message [note that because the request message was sent prior departure was sent in the actual CDMA mode requesting permission to use GSM] (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23).

As to claim 12, Fette discloses a method indicating an ability of the multi-mode wireless communications device to operate in a third communications mode [analog, TDMA, etc.] on one of the first and second network [note that because the request message was sent prior departure was sent in the actual CDMA mode requesting

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permission to use GSM] (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23).

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Karabinis US 20050079816A1.

As to claim 25, Karabinis discloses a method for network resource allocation in a first communications network, the method comprising: receiving a message from a multimode mobile station; generating a channel assignment message for the multimode mobile station operating in a first communications on the first network in response to the message; assigning the multimode mobile station to a second network in the channel assignment message; transmitting the channel assignment message to the multimode mobile station (see par. 0081, 0226, 0259-0261).

As to claim 26, Karabinis discloses a method of transmitting the channel assignment message to a wireless communications device connected to the first communications network, providing the second channel assignment information in the

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channel assignment message includes providing a direct channel assignment (see par. 0081, 0226, 0259, 0260).

As to claim 27, Karabinis discloses a method of transmitting the channel assignment message to a wireless communications device connected to the first communications network, providing the second channel assignment information in the channel assignment message includes providing an access grant channel for the communications device to complete set up on the second network (see par. 0081, 0226, 0259, 0260).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 2-4, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fette in view of Uchida US007072359B2.



As to claims 2 and 9, Fette discloses generating a message [SMS] indicating that the multi-mode wireless communications device is able to operate in GSM communications mode (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Fette does not disclose the message includes setting a first field indicating that the message includes a second field. However, in an analogous art Uchida discloses that SMS message includes setting a first field [message type, message identifier, num fields, etc] indicating that the message includes a second field (see fig. 2a, 2b; see col. 5, line 11 – col. 6, line 36). Uchida discloses the details of the anatomy of a SMS message, although Fette does not disclose the details of the SMS is using the same type of message, thereby having the same anatomy. Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention that SMS message have first field indicating details of the composition of the message for the simple purpose of correctly receiving the message according the information on the field.

As to claim 3, Fette discloses generating a message [SMS] indicating that the multi-mode wireless communications device is able to operate in GSM communications mode (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Fette does not disclose the message includes setting a second field. However, in an analogous art Uchida discloses the origination message includes setting the second field to indicate that the multi-mode wireless communications device is able to operate in GSM communications mode (see fig. 2a, 2b; see col. 5, line 11 – col. 6, line 36). Uchida discloses the details of the anatomy of a SMS message, although Fette does

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not disclose the details of the SMS is using the same type of message, thereby having the same anatomy. Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention that SMS message have first field indicating details of the composition of the message for the simple purpose of correctly receiving the message according the information on the field.

As to claim 4, Fette discloses the method of indicating whether the multi-mode wireless communications device is capable of communicating in at least one of a GSM mode (see col. 5, lines 5-13; col. 6, lines 3-23). Fette does not specifically disclose which GSM mode if is GSM single-slot mode or a GSM multi-slot mode. However, since the claim recites the two possible outcomes, inherently it have to be one of the two possibilities.

As to claim 11, Fette discloses generating a message [SMS] indicating that the multi-mode wireless communications device is able to operate in GSM communications mode (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Fette does not disclose setting a flag. However, in an analogous art Uchida discloses the origination message includes setting a flag indicating the presence of more information (see fig. 2a, 2b; see col. 5, line 11 – col. 6, line 36). Uchida discloses the details of the anatomy of a SMS message, although Fette does not disclose the details of the SMS is using the same type of message, thereby having the same anatomy. Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention that SMS message have first field indicating details of the composition of the

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message for the simple purpose of correctly receiving the message according to the information on the flag.

14. Claim 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karabinis in view of Fette and further in view of Muniere US 20040047343A1.

As to claim 20, Karabinis discloses a method of providing GSM channel assignment information in the channel assignment message (see par. 0259). Karabinis does not disclose providing information indicating that additional GSM channel assignment information is provided in the channel assignment message. In an analogous art, Muniere discloses providing information indicating that additional GSM channel assignment information is provided in the channel assignment message (see par. 0029, 0037, 0038). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to provide additional information for the simple purpose of providing more than one resource.

As to claim 22, Karabinis discloses a method of providing GSM channel assignment information in the channel assignment message includes providing information (see par. 0259). Karabinis does not specifically disclose including information to re-send one of an origination message or page response message on a GSM Channel. In an analogous art, Muniere discloses including information to re-send one of an origination message or page response message on a GSM Channel (see par. 0038). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to include information to re-send one of an origination message to request a more precise description of the required resources. Additionally re-send

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data is a common and well-known technique used when the information was incorrectly received or was not received.

15. Claims 19, 21, 23-24 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karabinis in view of Fette.

As to claim 13, Karabinis discloses a message for origination or page response by a multimode communications device, the message comprising: a first additional mode information field of the message for indicating an ability of a multimode communications device to accept a channel assignment and a second additional mode information field of the message for indicating an ability of the multimode communications device to accept a channel assignment in a second additional mode other than the first mode (see par. 0029, 0037, 0038). Karabinis does not specifically disclose a first additional mode. In an analogous art, Fette in a first additional mode other than a first mode or second mode [analog] (see col. 6, lines 3-24). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to include additional modes for the simple purpose of compatibility.

As to claim 19, Karabinis discloses a method in a first communications network (see par. 0044, 0164), the method comprising: generating a channel assignment message; providing GSM channel assignment information in the channel assignment message; transmitting the channel assignment message from a network infrastructure to a wireless communication device (see par. 0081, 0226, 0259, 0260). Karabinis does not specifically disclose including channel assignment information for a mode of operation pursuant to a second communications protocol. In an analogous art Fette

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discloses including channel assignment information from CDMA mode of operation pursuant to a GSM communications protocol (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention to combine the reference to provide compatibility with multiple modes.

As to claim 21, Karabinis discloses a method of providing G channel assignment information in the channel assignment message includes providing assignment information for one of a access grant channel (see par. 0259). Karabinis does not specifically disclose including channel assignment information for a mode of operation pursuant to a second communications protocol. In an analogous art Fette discloses including channel assignment information from CDMA mode of operation pursuant to a GSM communications protocol (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention to combine the reference to provide compatibility with multiple modes.

As to claim 23, Karabinis discloses a method of transmitting the channel assignment message to a wireless communications device connected to the first communications network, providing the channel assignment information in the channel assignment message includes providing a direct channel assignment (see par. 0081, 0226, 0259, 0260). Karabinis does not specifically disclose including channel assignment information for a mode of operation pursuant to a second communications protocol. In an analogous art Fette discloses including channel assignment information

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from CDMA mode of operation pursuant to a GSM communications protocol (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention to combine the reference to provide compatibility with multiple modes.

As to claim 24, Karabinis discloses a method of transmitting the channel assignment message to a wireless communications device connected to the first communications network, providing the channel assignment information in the channel assignment message includes providing an access grant channel for the communications device to complete set up on the network (see par. 0081, 0226, 0259, 0260). Karabinis does not specifically disclose including channel assignment information for a mode of operation pursuant to a second communications protocol. In an analogous art Fette discloses including channel assignment information from a CDMA mode of operation pursuant to a GSM communications protocol (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention to combine the reference to provide compatibility with multiple modes.

As to claims 28-30, Karabinis discloses a method in a multimode communications device, the method comprising: receiving a channel assignment message while operating in a first mode pursuant to a first communications protocol, the channel assignment message; transitioning to one of an access grant channel or a dedicated channel based on the channel assignment information for the different mode of operation (see par. 0081, 0226, 0259, 0260). Karabinis does not specifically disclose

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including channel assignment information for a mode of operation pursuant to a second communications protocol. In an analogous art Fette discloses including channel assignment information for a mode of operation pursuant to a second communications protocol (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention to combine the reference to provide compatibility with multiple modes.

### ***Allowable Subject Matter***

16. Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. The following is a statement of reasons for the indication of allowable subject matter: The method of receiving a channel assignment message, in response to sending the origination message, while operating in CDMA communications mode, the channel assignment message including GSM assignment information, have not been found or fairly suggested in the prior art search.

### ***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS L. TORRES whose telephone number is (571)272-7926. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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/George Eng/

Supervisory Patent Examiner, Art Unit 2617

/Marcos L Torres/

Examiner, Art Unit 2617